

REMARKS

STATUS OF THE CLAIMS:

Claims 1-25 are pending.

Claims 1, 3-19 and 21 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention."

Claims 1, 3-19 and 21 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly "failing to comply with the written description requirement."

Claims 1-13, 15, 16 and 18-25 are rejected under 35 U.S.C. § 102(e) as being anticipated by Lapstun et al., U.S. Patent No. 7,038,797, hereinafter referred to as "Lapstun."

Claim 17 is rejected under 35 U.S.C. § 103(a) as allegedly being rejected over Lapstun in view of Fredrickson, U.S. Patent Publication No. 2002/0019768, hereinafter referred to as Fredrickson.

Claim 14 is rejected under 35 U.S.C. § 103(a) as allegedly being rejected over Lapstun in view of Official Notice.

In accordance with the foregoing, the claims are amended and claims 19 and 20 are cancelled without disclaimer or prejudice, and, thus, the pending claims remain for reconsideration, which is respectfully requested.

No new matter has been added.

The Examiner's rejections are respectfully traversed.

**35 U.S.C. § 112, SECOND PARAGRAPH, REJECTIONS:**

Independent claims 1, 19 and 21 are allegedly rejected under 35 U.S.C. § 112, second paragraph.

The Examiner, on page 2, lines 15-17, asserts, "Examiner is interpreting the non-privileged service as a user needs to be register or pay or be a subscriber with the supplier to use the service and the service comes with an advertisement." Applicants respectfully disagree with the Examiner's interpretation, however, for clarity, the claims are amended to recite "a database which registers a supplier providing a first non-privileged service, said first non-privileged service being offered to users with and without a subscription for the first non-

privileged service with and said first non-privileged service having a first advertisement, and said data base registers the users that have a contract subscription with the supplier for the first non-privileged service,” as recited, for example, in claim 1. Claim 1 is further amended for clarity, to recite, in part, “an advertisement preparation unit for preparing a second advertisement, requested by an advertiser, to be provided as a second-privileged second service for subscription users to the first-non privileged service, and for by placing said second advertisement on a privileged Web page.” In one embodiment, an example of a “non-privileged service” is a newspaper. Therefore, according to the example, although any person could purchase the newspaper, only the “subscription users” would be able to access the claimed “privileged second service.” For example, a user with a subscription to the newspaper could log onto the “privileged website” and view the adds from the Sunday paper, where as a person without a subscription to the newspaper could not.

In accordance with the foregoing, the claims are amended, taking into consideration the Examiner’s comments. Accordingly, withdrawal of the indefiniteness claim rejection is respectfully requested.

#### 35 U.S.C. § 112, FIRST PARAGRAPH, REJECTIONS:

The Examiner, on page 3 of the Office Action, asserts that the “Applicant’s specification does not teach a privileged or non-privileged service.” Applicants respectfully disagree with the Examiner’s assertion, because, for example, the application specification, at page 31, lines 16 to 26, recites:

FIGs. 13A and 13B are explanatory drawings that show system functions of the privilege offering process to the user. When a contractor views an advertisement Web page 24 of the newspaper server 10 through the user client 18-1, he or she is allowed to receive the privilege set with respect to the advertisement thus viewed. Privileges to be given to the user for his or her visit to the advertisement include discount service and point service offered by the newspaper dealer or the advertiser.

Furthermore, for example, the application specification, at page 23, lines 5-18, recites:

The advertising system of the present invention is arranged so that only contractor for subscription with a newspaper dealer is allowed to access a Web page 24 supplied by the newspaper dealer server 10. In other words, the newspaper dealer daily delivers newspapers to the contractors based upon the newspaper subscription contract, and these subscription contractors are contractor users of the advertisement Web page 24 in the newspaper dealer server 10 of the advertising system in accordance with the present invention, and these contractor users

are registered in the contractor data base 28.

Furthermore, support for the claims can be found, for example, in FIGS. 8 and 9B.

Accordingly, applicants respectfully submit that the specification clearly contains a written description of the invention in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention. Furthermore, MPEP § 2163(I)(B) recites, in part:

While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.

Accordingly, applicants respectfully submit that one skilled in the art would be able to make and use the claimed "privileged service" and the claimed "non-privileged service."

The Examiner, on page 4, lines 2-4, further asserts "as understood by the Examiner the web site provides two services, publishing new and providing advertisement. The user who sees the publication also sees the advertisement." Applicants respectfully disagree with the Examiner's assertion, because claim 1 clearly recites, for example, "an advertisement preparation unit for preparing a second advertisement, requested by an advertiser, to be provided as a second-privileged second service for subscription users, and for by placing said second advertisement on a privileged Web page." Accordingly, Applicants respectfully submit that only "subscription users" of the first non-privileged service can see the second advertisement. Support for the claim amendment can be found, for example, in application specification, at page 23, lines 5-18, which recites:

**The advertising system of the present invention is arranged so that only contractor for subscription with a newspaper dealer is allowed to access a Web page 24 supplied by the newspaper dealer server 10.** In other words, the newspaper dealer daily delivers newspapers to the contractors based upon the newspaper subscription contract, and these subscription contractors are contractor users of the advertisement Web page 24 in the newspaper dealer server 10 of the advertising system in accordance with the present invention, and these contractor users are registered in the contractor data base 28.

Withdrawal of the 35 U.S.C. §112, first paragraph, claim rejection is respectfully requested.

#### **PRIOR ART CLAIM REJECTIONS:**

Independent claims 1, 2 and 18-25 are allegedly anticipated by Lapstrum.

The Office Action asserts that Lapstrum discusses "providing a first non-privileged service (access to publication or site) and users (registered subscribers, see col. 23 lines 33-42."

Applicants respectfully disagree with the Examiner's assertion, because Lapstrum at col. 23 lines 33-42, discusses:

**A subscriber can draw on two kinds of news sources:** those that deliver news publications, and those that deliver news streams. While news publications are aggregated and edited by the publisher, news streams are aggregated either by a news publisher or by a specialized news aggregator. News publications typically correspond to traditional newspapers and newsmagazines, while news streams can be many and varied: a "raw" news feed from a news service, a cartoon strip, a freelance writer's column, a friend's bulletin board, or the reader's own e-mail.

In other words, Lapstrum discusses a privileged service in which a subscriber to the netpage service can receive the news. However, Lapstrum fails to disclose, either expressly or inherently, the claimed "a database which registers a supplier providing a first non-privileged service, said first non-privileged service being offered to users with and without a subscription for the first non-privileged service with and said first non-privileged service having a first advertisement, and said data base registers the users that have a contract subscription with the supplier for the first non-privileged service," because Lapstrum only offers the netpage service to "subscribers." In other words, Lapstrum fails to disclose, either expressly or inherently, the claimed "first non-privileged service being offered to users with and without a subscription for the first non-privileged service" because the netpage subscription service is only available to a subscriber of the netpage subscription service, that is, the non-privileged service is offered, for example, to a user who has a subscription to the service and is also available to a user who does not have a subscription.

The Office Action further asserts, on page 5, lines 1-3, that the claimed "privileged second service" is disclosed by Lapstrum because Lapstrum discusses that netpage users can "print" their netpages. See, for example, Lapstrum at column 13, lines 44-49, which recites:

The netpage printer 601 is an appliance which is registered with the netpage system and **prints netpage documents on demand and via subscription.** Each printer has a unique printer ID 62, and is connected to the netpage network via a network such as the Internet, ideally via a broadband connection.

Applicants respectfully disagree with the Examiner's assertion, because claim 1, for example, recites "an advertisement preparation unit for preparing a second advertisement, requested by an advertiser, to be provided as a second-privileged second service for subscription users to the first-non privileged service, and for by placing said second advertisement on a privileged Web page." Accordingly, applicants respectfully submit that

Lapstum's netpage printers fail to disclose, either expressly or inherently, the claimed "privileged second service" because the claimed "privileged second service" is clearly a privilege for a non-privileged service, and Lapstrum is silent on any non-privileged service.

Independent claim 2 relates to a advertising server, which includes:

a contractor database that registers contractors  
subscription users that have a subscriber-subscription contract  
contracts with a newspaper dealer to deliver a newspaper to  
the subscription users;

an advertisement preparation unit for preparing an  
advertisement requested by an advertiser and for placing said  
advertisement on a privileged Web page ~~so as to be viewed~~; and

an advertisement utilization unit which, ~~in the case when~~ a  
user is identified as a ~~contractor~~ subscription user ~~having a~~  
subscription contract for the newspaper on the database through  
the inputted user information, allows the subscription user to  
view said advertisement on the privileged Web page as a  
privilege service provided under said subscription contract;

wherein the advertisement view is provided to the  
subscription user at an independent time and by a different  
medium from a delivery of ~~a~~ the newspaper.

Accordingly, Applicants respectfully submit that claim 2 patentably distinguishes over the cited prior art for similar reasons as independent claim 1.

Furthermore, Applicants respectfully submit that independent claims 18 and 21-25  
patentably distinguish over the cited prior art for similar reasons as independent claims 1 and 2.

Dependent claims recite patentably distinguishing features of their own or are at least  
patentably distinguishing due to their dependence from the independent claims. Withdrawal of  
the rejection of pending claims, and allowance of pending claims is respectfully requested.

### CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the  
application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested  
to telephone the undersigned to attend to these matters.

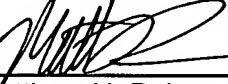
Serial No. 10/001,992

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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